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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,351	02/06/2004	Douglas F. Reynolds	1033-LB1011	5256
60533	7590	11/14/2008	EXAMINER	
TOLER LAW GROUP 8500 BLUFFSTONE COVE SUITE A201 AUSTIN, TX 78759			GAUTHIER, GERALD	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,351	<b>Applicant(s)</b> REYNOLDS ET AL.
	<b>Examiner</b> Gerald Gauthier	<b>Art Unit</b> 2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 October 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14, 18-26, 29-33, 48 and 54-69 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14, 18, 19, 21-24, 26, 29-33, 48 and 54-69 is/are rejected.  
 7) Claim(s) 20 and 25 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim(s) 1** is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

**Claims 2-14 and 54-67** are rejected under 35 U.S.C. 101 because they are dependent of claim 1 above.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. **Claims 1-14, 18, 19, 21-24, 26, 29-33, 48 and 54-69** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (US 7,280,530 B2).

Regarding **claim 1**, Chang discloses a call indication method comprising:  
recognizing a request to complete a voice over Internet protocol call to a called party [a caller (not illustrated) initiates a call by picking up the handset on the caller telephone 38 and dialing an ARS code, e.g. "9" for an off-net call or "8" for an on-net call, plus a PST NETWORK telephone number or other digit string, column 27, lines 50-65]);

receiving custom ring information from a calling party of the VoIP call, the custom ring information representing a calling party ring tone to be played to the called party, determining whether the calling party selected ring is allowed [the caller would select the ring through option in the browser window at the caller workstation. The browser passes the selection to the caller gateway server. If the caller is not logged on, the caller would select the ring through option by pressing a designated key on the telephone. The caller gateway server 26 detects the DTMF tone selecting the ring through option. The caller gateway server 26 then notifies the called gateway server 126 that the caller has requested to ring through. The called gateway server 126 places an inbound call to the called PBX 134 for the called telephone 138, column 48, lines 46-62]; and  
when the calling party selected ring tone is allowed, initiating delivery of the custom ring information to the called party [If the called user accepts the call alert, a message is passed to the called gateway server 126. The called CTI driver 180 passes a message to the called PBX 134 to place the current call on hold. The called analog driver 167 delivers the new call to the called PBX 134. The called PBX 134 rings the called telephone 138, column 48, lines 11-25].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Chang to follow the caller selected ring using the teaching of the called party accepting or rejecting the alert signal because doing so would allow the gateway to terminate the call to the called party.

Regarding **claims 2 and 54**, Chang discloses a call indication method, further comprising utilizing a Public Switched Telephone Network node to perform at least one of the recognizing step, the receiving step, and the initiating step [column 27, lines 32-47].

Regarding **claims 3 and 55**, Chang discloses a call indication method, further comprising recognizing that a piece of customer premises equipment associated with the called party comprises specialized ring tone functionality operable to output the desired ring tone [column 48, lines 11-25].

Regarding **claim 4**, Chang discloses a call indication method, further comprising delivering at least a portion of the custom ring information in VoIP packets [column 48, lines 11-25].

Regarding **claim 5**, Chang discloses a call indication method, further comprising delivering the custom ring information across a wireline connection comprising a link of coaxial cable operable to carry data traffic [column 48, lines 11-25].

Regarding **claim 6**, Chang discloses a call indication method, wherein a VOIP switch initiates delivery of the custom ring information to the called party [column 48, lines 11-25].

Regarding **claims 7, 38 and 56**, Chang discloses a call indication method, further comprising: prompting the calling party to communicate the custom ring information [column 27, lines 32-47]; and

recording the custom ring information [column 27, lines 32-47].

Regarding **claims 8 and 57**, Chang discloses a call indication method, further comprising utilizing a piece of calling party CPE to perform at least one of the recognizing step, the receiving step, and the initiating step [column 27, lines 32-47].

Regarding **claims 9, 28 and 45**, Chang discloses a call indication method, wherein at least a portion of the custom ring information has a file format selected from the group consisting of a .WAV file, a .MIDI file, and an AU file [column 27, lines 32-47].

Regarding **claims 10, 39, 52 and 53**, Chang discloses a call indication method, wherein at least a portion of the custom ring information represents a spoken message [column 27, lines 32-47].

Regarding **claims 11, 40 and 58**, Chang discloses a call indication method, wherein recognizing the request to complete the VOIP call occurs after receiving the custom ring information [column 48, lines 11-25].

Regarding **claims 12, 41 and 59**, Chang discloses a call indication method, further comprising storing the custom ring information in a memory residing in a piece of calling party customer premises equipment [column 48, lines 11-25].

Regarding **claims 13, 37, 42 and 60**, Chang discloses a call indication method, further comprising storing the custom ring information in a memory located within a service provider network [column 48, lines 11-25].

Regarding **claims 14 and 61**, Chang discloses a call indication method, further comprising: recognizing caller identification information of the calling party [column 48, lines 11-25]; and

finding a location in the memory that is storing the custom ring information [column 48, lines 11-25].

Regarding **claim 18**, Chang discloses all the limitations of claim 18 as stated in claim 1's rejection above.

Regarding **claims 19 and 62**, Chang discloses a ring tone delivery system, wherein the network node comprises a VOIP switch operable to communicatively couple to a plurality of subscribers across links comprising twisted pair wiring [column 48, lines 11-25].

Regarding **claims 21 and 63**, Chang discloses a ring tone delivery system, wherein the network node is further operable to deliver packetized information across a cable network [column 48, lines 11-25].

Regarding **claims 22 and 64**, Chang discloses a ring tone delivery system, wherein the network node is further operable to deliver packetized information across an XDSL network [column 48, lines 11-25].

Regarding **claims 23 and 65**, Chang discloses a ring tone delivery system, further comprising a custom ring tone block list, wherein the network node is further operable to block delivery of the calling party selected ring tone when the custom ring tone block list indicates that the called party does not want to receive the calling party selected ring tone [column 48, lines 11-25].

Regarding **claims 24 and 66**, Chang discloses a ring tone delivery system, further comprising a broadband modem providing at least a portion of a link

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communicatively coupling the network node to a piece of telephonic equipment associated with the called party [column 48, lines 11-25].

Regarding **claim 26**, Chang discloses all the limitations of claim 26 as stated in claim 1's rejection above.

Furthermore Chang discloses an electronic device [95 on FIG. 3], a memory [108 on FIG. 3], a user interface [95 on FIG. 3] and an output engine [138 on FIG. 4].

Regarding **claims 29 and 67**, Chang discloses a system, wherein the memory stores additional ring tone information representing a second select ring tone, further wherein the select ring tone is associated with the called party and the second select ring tone is associated with a different party [column 48, lines 11-25].

Regarding **claims 30 and 68**, Chang discloses a system, further comprising an electronic address book comprising a listing for the called party and a second listing for the second party [column 48, lines 11-25].

Regarding **claim 31**, Chang discloses all the limitations of claim 31 as stated in claim 1's rejection above.

Regarding **claims 32 and 69**, Chang discloses a computer-readable medium having additional computer-readable data to determine if the called party desires delivery of the information [column 48, lines 11-25].

Regarding **claim 33**, Chang discloses all the limitations of claim 33 as stated in claim 1's rejection above.

Regarding **claim 48**, Chang discloses all the limitations of claim 48 as stated in claim 1's rejection above.

***Allowable Subject Matter***

6.     **Claims 20 and 25** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7.     Applicant's arguments with respect to **claims 1-14, 18-26, 29-33, 48 and 54-69** have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/  
Primary Examiner, Art Unit 2614

/GG/  
November 15, 2008